

REMARKS

Applicants are in receipt of the Office Action mailed September 28, 2010, in the nature of requirements for restriction and election of species. Applicants reply below.

First, however, as Applicants have claimed priority, and as the USPTO has received a copy of the Japanese priority applications, Applicants hereby respectfully request the examiner to acknowledge receipt of Applicants' foreign priority papers filed under Section 119.

Restriction has been required between what the PTO considers as being four (4) separate inventions on the basis of purported lack of unity of invention as per PCT Rules 13.1 and 13.2. As Applicants must make an election even though the requirement is traversed, Applicants hereby respectfully and provisionally elect Group I, which the USPTO has designated as comprising claims 23-36, with traverse and without prejudice.

The USPTO has taken the position that unity of invention is destroyed by Roy et al. (1991, JBC 266(8):4758-4763), but Applicants respectfully disagree. Even if Roy et al. were interpreted to anticipate or make obvious the broadest presently pending claims (which it does not), there would still be common patentable subject matter existing in the recited groups, thereby meeting the requirements of a technical

relationship between the groups of inventions involving one or more of the same or corresponding special technical features, as required by PCT Rules 13.1 and 13.2.

Withdrawal of the rejection is in order and is respectfully requested.

As best understood by Applicants, the examiner also requires Applicants to elect a single species for each of a promoter, a gene, and cell, from those listed at page 3 of the Action, for further prosecution on the merits. Again, as Applicants must make an election even though the requirement is traversed, Applicants hereby respectfully and provisionally elect "chicken β -actin promoter" as the species of promoter, "dihydrofolate reductase (dhfr) as the species of gene, and Chinese hamster ovary cells (CHO cells) as the species of cell, with traverse and without prejudice. Claims 23-26 read on (cover) the elected species, and indeed, as all such claims are believed to be generic.

The requirement is respectfully traversed on the basis that the generic claims themselves define a single general inventive concept under PCT Rules 13.1 and 13.2 because such claims themselves recite the same or corresponding special technical features. Accordingly, withdrawal of the rejection is in order and is respectfully requested.

For these reasons, it is respectfully submitted that all the claims now present in the case are directed to a single general inventive concept sharing the same or corresponding special technical feature. Thus, it is believed that Applicants are entitled to an action on the merits of all pending claims, in their full scope, in the present application. Reconsideration and withdrawal of this requirement is therefore earnestly requested.

Even though US rejoinder practice does not apply in this case, please consider the possibility of rejoinder of the non-elected invention, upon a determination that the claims are deemed to be free of the art and have Unity of Invention. Similarly, please also consider and examine additional species upon a determination that the elected species is free of the prior art.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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